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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,943	01/31/2001	Ronald Jacoby	17887-004600US	9158
20350	7590	01/04/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			CARLSON, JEFFREY D	
TWO EMBARCADERO CENTER			ART UNIT	PAPER NUMBER
EIGHTH FLOOR				3622
SAN FRANCISCO, CA 94111-3834			DATE MAILED: 01/04/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/773,943	JACOBY ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2 and 4-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/24/03, 11/1/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 10/14/05.

Information Disclosure Statement

2. Applicant's IDS filed 3/24/2003 and 11/1/2004 have been reviewed. Two NPL references from the 3/24/03 IDS have not been considered due to a problem printing the full right margin. Appicant must furnish a complete copy of the references in order for them to be considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2, 4-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz et al (US6760916). Holtz et al teaches [fig 11, abstract] a media player on a client machine that enables a user to build custom playlists for content to be streamed to the user. The client renders the stream as well as simultaneously renders/displays other content such as HTML content/window 1108a, banner 1114a, browser content 1112, etc. Holtz et al teaches that enhancements to the streaming content can include ads such as banners, sponsorships, scrolling element and buttons/links [34:27-31, 46-50].

The ads can be linked to each content segment requested so the user can view such ads when also viewing the streaming content [4:5-19]. The streaming content includes a metafile (playlist) script that defines commands for including particular filesstreams as well as advertising, text, graphic elements and hyperlinks associated with the video and topic being streamed which are linked to each content segment [8:60 to 9:20]. The ads can be integrated into the media stream at any point [9:51-53]. The ads come from remote databases/sources. The ads can be programmed to run before, during or after each streaming segment content [34:32-39]. The ads can be shown in the same content frame or in other frames [35:5-12]. Holtz et al teaches HTML banner ad sponsorship 1114b that is shown simultaneously with the particular requested content segment [37:26-34]. Holtz et al also teaches informative supporting media that is linked to run simultaneously with the streaming content [38:35-56, 39:10-17, 40:54 to 41:10, 41:35-54, 43:51-64, 44:2-8]. This content could also be considered to be "advertising." The client application of Holtz et al is taken to be a browser with various frame sets that contain the disclosed content and is capable of browsing the web, displaying HTML content and enabling hyperlinks. Holtz et al is taken to inherently include directory construction and searching for files which define the parameters of the frames in order to properly render the frames as well as the content that is rendered within them. Holtz et al teaches logging when the ads are played [abstract, 4:48-50].

Response to Arguments

Applicant argues that Holtz et al ('916) is not prior art because the 102(e) date relies upon a CIP-based continuation. Examiner has furnished applicant a copy of the parent specification of Holtz (09/634735) in order demonstrate that full support for the disclosure needed to reject applicant's claims was present in Holtz et al ('916).

In particular, Holtz et al (09/634735) provides the most relevant disclosure on pages 68-78. Holtz et al (09/634735) teaches on demand streaming over the Internet [68:24-27], segment identifiers [70:3-6], creation of a playlist [70:8-23], user-customized broadcasts and assembly of a playlist stream based upon user profile [71:27-72:8], a separate frame for synchronized content [72:11-20, 73:7-13, 73:25-28, 74:1-8], insertion of ads at various location [72:20-30, 76:17-22] and logging of advertising viewing [74:14-17].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc